

REMARKS

Applicants note that during prosecution of the parent PCT Application, PCT/JP00/06267, claims 1 and 2 have been amended and the specification has been amended at page 2, lines 4-8. However, the Examiner appears to have not taken into consideration the amended claims when preparing the outstanding Office Action. Since the Examiner has not provided an Office Action that takes into consideration claim 2¹ as amended during prosecution of the PCT Application, Applicants respectfully request that the Examiner does not issue a Final Office Action in response to this Reply.

For clarity of the record, Applicants have amended the paragraph at page 2, lines 4-8 of the present specification, consistent with the amendments made during prosecution of the PCT Application.

Claims 1-5 are pending and stand ready for further action on the merits.

Claim 1 has been amended to recite that the tape tab, side flap and hot-melt adhesive are composed of materials rendering the side flap torn near a joint when pulled at a peel angle of 180° at a speed of 100 m/minutes. Support for this amendment can be found at page 10, lines 12-16 and in Table 1 of the present specification. Claim 1 has also been amended to recite that the

¹ Claim 2 as amended during PCT prosecution recites that the non-woven fabric making said side flap has a basis weight of 7 to 30 g/m².

hot-melt adhesive has a viscosity of 30 to 100 Pa·s at 140°C, which finds support at page 5, line 19 of the specification. All other changes to claims 1-2 and to the specification at page 2, lines 4-8, are consistent with the changes made during prosecution of the parent PCT Application.

We now turn to the issues raised in the outstanding Office Action.

Issues under 35 U.S.C. 103

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alper et al. (U.S. Patent 5,149,741). Applicants respectfully traverse the rejection.

As noted above, the Examiner has provided comments on the claims, which were in the form prior to amendments made during PCT prosecution. During PCT prosecution, claim 1 was amended to recite the subject matter of claim 2. Accordingly, Applicants now discuss the Examiner's arguments for unpatentability of claims 2-5 over Alper et al.

Alper et al. teach the following invention:

[h]ot melt construction adhesives are described which possess superior properties for the construction of disposable soft articles. The adhesive compositions include an SIS copolymer containing at least about 25% styrene, a compatible tackifying resin, a plasticizing oil and an effective amount of a stabilizer.

Thus, the teachings of Alper et al. are directed toward the composition of the hot-melt adhesives. Applicants note that Alper et al. briefly describe that the adhesives are useful in the assembly of disposable soft goods, such as for "disposable diapers, feminine napkins or the like." See column 17, lines 54-56. However, Alper et al. fail to teach or fail to suggest any specific features of the disposable diaper, as presently claimed, as noted by the Examiner at page 3, first full paragraph of the outstanding Office Action. In order to cure this deficiency, the Examiner states:

[h]owever, it is old and well known to one of ordinary skill in the art that diaper fasteners are located in the rear portion of the diaper to assist the caregiver in positioning the diaper on the wearer.

First, Applicants respectfully challenge the above statement and request evidence that it would be obvious to prepare a disposable diaper having a side flap provided on each side of a back portion of the diaper, which is, while worn, positioned in the back of the wearer, a tape tab for fastening the diaper is provided

on each side flap, wherein said side flap is made of non-woven fabric and said tape tab is fixedly joined to said side flap with a hot-melt adhesive. Without such evidence, Applicants maintain that the instantly claimed invention is not obvious over Alper et al.

Second, Applicants have amended independent claims 1 and 3 by limiting the possible materials used in the tape tab, side flap and hot-melt adhesive. The inventive claims now recite that the materials of the tape tab, side flap and hot-melt adhesive are chosen such that the side flap is torn near a joint when pulled at a peel angle of 180° at a speed of 100 m/min. Thus, the tape tab must be made of a material that is more resistant to tearing than the side flap. Also, the adhesive must provide a strong enough bond so that the side flap tears before the entire adhesive seal is broken.

Further, claim 1 has been amended to limit the melt viscosity of the present invention into the range, which does not overlap with the melt viscosity of the Alper Reference. The Alper Reference discloses the melt viscosity of hot melt adhesives at a temperature of 325°F (163°C), whereas claim 1 recites the melt viscosity at a temperature of 140°C. For the comparison of the melt viscosity at the same temperature, i.e., 140°C, if the melt viscosity of the Alper Reference is shifted to the temperature of 140°C, the shifted melt viscosity does not overlap with the claimed range of the melt viscosity of 30 to 100 Pa.s.

According to MPEP § 2143.03, a *prima facie* case of obviousness cannot be said to exist, unless the cited reference teaches or fairly suggests all claim limitations. Since Alper et al. are silent regarding the materials used in the tape tab, side flap and hot-melt adhesive with respect to one another, a *prima facie* case of obviousness cannot be said to exist. Accordingly, withdrawal of the rejection is respectfully requested.

PTO-892 Form

On the PTO-892 Form, which was enclosed with the outstanding Office Action, the Examiner cites Baker et al., U.S. Patent 3,792,801; Lauritzen, U.S. Patent 5,417,789 and Nakanishi, U.S. Patent 4,520,049. However, the Examiner has not indicated why these references have been cited (background of the invention?). Applicants respectfully request that the Examiner clarifies for the record why these three U.S. Patents were cited on the PTO-892 Form enclosed with the outstanding Office Action.

Conclusion

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A Notice to such effect is earnestly solicited.

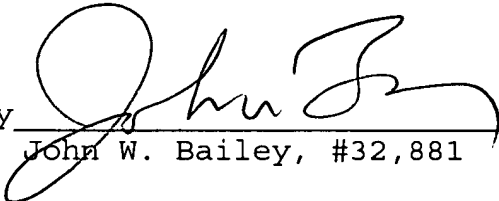
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully

requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment:

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